

REMARKS

Applicants thank the Examiner for acknowledging the claim for priority under 35 U.S.C. § 119, and receipt of certified copies of the priority document submitted January 28, 2004.

Applicants thank the Examiner for considering the references cited with the *Information Disclosure Statement* filed January 28, 2004.

Applicants thank the Examiner for acknowledging the election without traverse of claims 1-6 and 15-31 in the *Response to Election of Species Requirement* filed January 12, 2005.

Status of the Application

All of the pending and elected claims 1-6 and 15-31 of the instant Application stand rejected. Claims 7-14 stand withdrawn in view of the January 12, 2005 *Response to Restriction Requirement*.

Claim Objections

The Examiner has objected to claim 16 due to an informality. The informality noted by the Examiner has been corrected. Thus, withdrawal of the objection is respectfully requested.

Rejection Under Obviousness-Type Double Patenting

The Examiner has provisionally rejected claims 1-6 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 12 of copending Application No. 10/773,313.

Applicants submit herewith a terminal disclaimer limiting the terminal part of any patent granted on the instant Application that would extend beyond the expiration of any patent issuing from Application No. 10/773,313. Thus, withdrawal of the rejection is respectfully requested.

Anticipation Rejection

The Examiner has rejected (1) claims 1-6 and 15-22 under 35 U.S.C. § 103(a) as being unpatentable over *Grulick et al.* (US 6,293,081; hereinafter “*Grulick*”) in view of *Epstein* (US 6,478,229; hereinafter “*Epstein*”); (2) claims 23-27 under 35 U.S.C. § 103(a) as being unpatentable over *Grulick* in view of *Epstein* and *Duron et al.* (US 2004/0135691; hereinafter “*Duron*”); and (3) claims 28-31 under 35 U.S.C. § 103(a) as being unpatentable over *Epstein* in view of *Duron*. These rejections are respectfully traversed.

Independent Claim 1

The Examiner alleges that *Grulick* discloses many of the features of independent claim 1, but concedes that *Grulick* fails to teach or suggest the use of any RFIDs (O.A., pg. 3). In an attempt to correct this deficiency, the Examiner applies *Epstein*, and alleges that one of ordinary skill in the art at the time of the invention (“one of skill”) would have replaced the identification markings P of *Grulick* with the RFIDs disclosed in *Epstein*. Applicants respectfully disagree.

Specifically, identification markings P of *Grulick* are marks that allow a craftsman to be able to locate a reversal area within the fiber optic cable 10. Thus, the identification marks P are primarily directed to establishing a particular location on the fiber optic cable 10.

In contrast, while *Epstein* discloses that RFIDs can efficiently store information, such as inventory information, *Epstein* fails to teach or suggest that the RFIDs can be used as positional locators similar to the markings in *Grulick*. In fact, neither *Grulick* nor *Epstein* teaches or suggests any particular way that *Epstein*'s RFIDs could be provided in *Grulick* so that a craftsman would be able to locate a reversal area on the fiber optic cable.

Thus, Applicants respectfully submit that one of skill would not have been motivated to provide the RFIDs of *Epstein* as replacement for the marks P in *Grulick*, as the resultant combination would fail to provide the positional location function of the marks P, and would therefore render *Grulick* unsatisfactory for its intended purpose.¹

Further, Applicants respectfully submit that, even if one of skill would have been motivated to modify *Grulik* in view of *Epstein*, the resultant combination would still fail to teach or suggest: “a plurality of radio frequency identification elements;” or “a sheath covering the cable core and the radio frequency identification elements.”

First, even if one of skill would have been motivated to add *Epstein*’s RFID to the fiber optic cable 10 of *Grulick*, he would have added only a single RFID, not multiple RFIDs. There is no teaching or suggestion of why multiple RFIDs would be added, or what non-redundant function they would perform. Rather, *Epstein* discloses the removal of a single RFID from the roll of RFIDs, and the application of that single RFID to a single package for inventory control. *Epstein* does not disclose the use of multiple RFIDs on a single package.

Second, even if one of skill would have been motivated to add *Epstein*’s RFID to the fiber optic cable 10 of *Grulick*, he would have arranged the RFID to be adhered to the outer surface of the fiber optic cable 10 in view of the teachings of *Epstein*. There is no teaching or suggestion that would lead one of skill to provide the RFID as an internal component of fiber optic cable, nor any teaching or suggestion that the RFID of *Epstein* would even function if

¹ If the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984); *MPEP* § 2143.01.

installed within the fiber optic cable 10. Rather, *Epstein* discloses the provision of a single RFID on tape to be placed on the surface of a package.

Thus, Applicants respectfully submit that independent claim 1 is patentable over the applied references. Further, Applicants respectfully submit that rejected dependent claims 2-27 are allowable, at least by virtue of their dependency, and are separately patentable over the applied references.

For example, Applicants respectfully submit that the applied references fail to teach or suggest dependent claim 15's recitation of "an integrated member containing the plurality of radio frequency identification elements in a chain." Applicants respectfully disagree with the Examiner's allegation that *Epstein's* configuration of RFIDs 16 and tape 2 is similar to the recited "integrated member," and that this "integrated member" would have been provided in *Grulick*. Rather, Applicants respectfully submit that *Epstein* does not teach or suggest providing multiple RFIDs in a portion of tape 2 on a single package. Rather, *Epstein* discloses that the individual RFIDs 16 are separated and individually provided on packages.

Further, Applicants respectfully submit that the applied references fail to teach or suggest dependent claim 20's recitation that "the distance between radio frequency identification elements is approximately equal to the maximum transmittable distance between a radio frequency identification element and a read/write device." Applicants respectfully disagree with the Examiner's allegation that a combination of *Grulick* and *Epstein* discloses all of the features of dependent claim 20. Rather, Applicants respectfully submit that, even if one of skill would have been motivated to provide multiple RFIDs on *Grulick* in view of *Epstein* (which he would not have) there is no teaching or suggestion that the RFIDs would be separated by a distance

equivalent to a transmittable distance. Neither reference discloses any concept of a transmittable distance, or the arrangement of any RFIDs in consideration thereof.

Further, Applicants respectfully submit that the applied references fail to teach or suggest dependent claim 21 and 22's recitation that the plurality of radio frequency identification elements are arranged "helically around the cable core" (claim 21) and "longitudinally along the cable core" (claim 22). Applicants respectfully disagree with the Examiner's allegation that a combination of *Grulick* and *Epstein* discloses all of these features. Rather, Applicants respectfully submit that, even if one of skill would have been motivated to provide multiple RFIDs on *Grulick* in view of *Epstein* (which he would not have), there is no teaching or suggestion that the RFIDs would be arranged in any particular pattern. Neither reference discloses any concept of any arrangement of RFIDs in a pattern.

Still further, Applicants respectfully submit that the applied references fail to teach or suggest dependent claim 23 and 24's recitation of a "pair of transmission wires" that are "arranged in proximity to the plurality of radio frequency identification elements" (claim 23) or "connected to the plurality of radio frequency identification elements" (claim 24). Applicants respectfully disagree with the Examiner's allegation that a combination of *Grulick*, *Epstein* and *Duron* discloses all of these recited features. Rather, Applicants respectfully submit that *Duron* discloses the provision of discrete transmission wires 28 along the surface of individual packages that are adjacently stacked on a pallet so that packages on the inside of the pallet can receive RFID transmissions, but fails to teach or suggest connecting multiple RFIDs with a single wire 28. Thus, even if one of skill would have been motivated to provide multiple RFIDs on *Grulick*

in view of *Epstein* (which he would not have) he would not have been motivated to connect the RFIDs by a transmission wire.

Independent Claim 28

Similarly to independent claim 1, the Examiner alleges that a combination of *Epstein* and *Duron* discloses all of the features of independent claim 28. Applicants again disagree.

Specifically, Applicants respectfully submit that *Epstein* and *Duron*, alone or in combination, fail to teach or suggest “a plurality of radio frequency identification elements” and “a pair of transmission wires” between a first and second joining tape.

Rather, Applicants respectfully submit that, as discussed above, *Epstein* discloses the removal of a single RFID from the roll of RFIDs, and the application of the single RFID to a package. *Epstein* does not disclose the use of multiple RFIDs on a single package.

Accordingly, as the RFIDs are used separately, there would have been no need to connect the RFIDs by any transmission wire in tape 2. As there would have been no need to connect the RFIDs in tape 2, one of skill would not have provided the transmission wires 26 of *Duron* in the tape roll 2 of *Epstein* as the Examiner alleges.

Thus, Applicants respectfully submit that independent claim 28 is patentable over the applied references. Further, Applicants respectfully submit that rejected dependent claims 29-31 are allowable, at least by virtue of their dependency, and are separately patentable over the applied references.


Conclusion

In view of the foregoing, it is respectfully submitted that claims 1-31 are allowable. Thus, it is respectfully submitted that the application now is in condition for allowance with all of the claims 1-31.

If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

Please charge any fees which may be required to maintain the pendency of this application, except for the Issue Fee, to our Deposit Account No. 19-4880.

Respectfully submitted,


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